

TEXAS INSTRUMENTS



November 22, 1996

SEND VIA FACSIMILE
703-308-6916

Ass't Commissioner for Patents
U.S. Patent & Trademark Office
Washington, DC 20231

ATTN: Jeffrey V. Nase

RE: PTO Proposal Making Miscellaneous Amendments to Patent Rules of Practice (60 Fed. Reg. 49820)

Dear Sir:

Texas Instruments Incorporated ("TI") offers the following comments on the proposed regulations promulgated by the Patent and Trademark Office (the "PTO") in 60 Fed.Reg. 49820.

TI has two major concerns. First, although we applaud the PTO's desire to simplify the rules, we do not understand how consolidating several rules into one rule (e.g., §1.115) serves to simplify the rules.. Second, the PTO's attempts to eliminate rules (e.g, §1.104, §1.105 and §1.108) that establish minimum requirements for PTO operations as "internal affairs" seem to be inconsistent with increased certainty in and predictability of PTO operations.

The proposed rules are generally acceptable as proposed. However, rather than commenting on all the proposed rule changes, we offer the following detailed comments for only those sections we suggest modifying or clarifying.

§1.53(b)(1)(i)(A) and §1.53(b)(3)(iii) - The statement requesting deletion of non-inventors in a continuation or divisional application should be allowed to be filed at any time prior to or coincident with mailing of an issue fee payment. Is §1.53(c)(1) intended to allow for a limited period of correction for this? *Ab*

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§1.53(b)(3) - This section only applies to complete non-provisional applications filed on or after June 8, 1995, or basically post-GATT non-provisional applications. Should this section apply to pending applications filed pre-GATT, e.g. before June 8, 1995? What about the post-GATT procedures for "old" (filed before June 8, 1993) pre-GATT applications? What about the post-GATT "after final" transitional procedures?

§1.59(a)(2) - If an application includes a design code listing as an appendix, may it be expunged, or is it considered part of the original disclosure? What are some examples of things that may be expunged? *see § 1.59(a)(2), depends on disc*

§1.104; §1.105; §1.108 - We believe it is important to continue to have regulatory requirements for the PTO included in the rules. These rules serve as one way to illustrate minimum PTO procedures during litigation.

§1.111(b) - Is the addition of "the specific distinctions", even for new claims, intended to require an exhaustive list of all distinctions or merely a discussion of at least one distinction. For example, if the Examiner incorrectly makes a §102 rejection that should have been a §103 rejection, is it sufficient to overcome the §102 rejection or must the proper §103 rejection be anticipated and answered? *No, but it will prevent the 103 from issuing.*

The prospect of distinguishing a newly added claim before it has been examined by an Examiner, seems to shift the burden to Applicant of creating straw-man rejections and then overcoming them. Does the PTO intend to create prosecution history estoppel?

§1.113(c) - This is helpful to patent prosecution procedures.

§1.115(b) - This section does not include the second and third sentence of the old §1.118(a). If §1.118(a) is to be moved to §1.115(b), include all of that old section.

§1.115(d), (e) and (f) - Does consolidating other rules into this rule serve any real purpose?

§1.115(e) - A sketch is required in "permanent ink". Should this be broadened to include a copy? *get a better drawing*

§1.121(a)(1)(iii) - This section requires more paperwork not less. If this section remains as is, the corrected pages should only be required to be submitted with payment of the issue fee.

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§1.121(2)(c)(ii) and (iv) - Again, this requires more paperwork, not less. As a counter proposal, any response should list the pending claims by number (even those not being amended). Again, a clean set of claims should only be required to be submitted with payment of the issue fee, if this section remains as is. ✓

§1.136(a)(3) - Does the "paper" need to be a separate document or may it also be a "standard" sentence in a reply to the PTO? *Yes* ✓

§1.137(a) - A "lapsed" patent for failure to pay an issue fee seems incongruous; the patent never "issued", how can it "lapse"? Perhaps another word would be more appropriate. ✓

§1.193(b) - As a practical matter, it may be difficult to prepare a substitute appeal brief that addresses both the rejections appealed from and any new arguments present in the Examiner's answer in a coherent and readable fashion. One possible solution is to add the "Reply Brief" to the prior "Appeal Brief" as a post-answer argument section and restyle the Appeal Brief as the "Substitute Brief". This does not appear to simplify things. ✓

§1.196(b) - Appellant should be able to respond to any new ground of rejection from the Board directly to the Board, not the Examiner. *Yes, §1.196(b)(2) is wrong, but to whom it is referred is not clear.*

§1.196(d) - The left bracket for (d) is on the wrong side of "(d)". *Yes*

§1.129(c) - The addition of "except for additional prior art" poses a risk that a third party may sequentially submit individual pieces of prior art as a delaying factor. *Will not be considered*

Please feel free to contact me if you would like to discuss any of our comments.

Respectfully submitted,

James L. Hesterson
Richard L. Donaldson
Senior Vice President,
Corporate Staff and General
Patent Counsel

RLD/CAM/reb